

REMARKS

Claims 1-5, 10, 12, 14, 16, 18, 19, 22, 24-27, 30, 32, 34, 36, 56-62, 68, 70, 72, 74, 77-79, 84-89, and 94-96 are currently pending. Claims 1, 3, 4, 10, 12, 56, 58-62, 68, 70, and 74 are allowable. Claims 2, 5, 14, 16, 18, 19, 22, 24-27, 30, 32, 34, 36, 57, 72, 77-79, 84-89, and 94-96 are rejected. Applicant thanks the Examiner for allowing the aforementioned allowable claims.

Claims 2, 5, 14, 16, 18, 19, 25-27, 72, 79, and 89 have been amended and Applicant has presented arguments to overcome the rejection of Claims 77 and 87. Claims 22, 24, 30, 32, 34, 36, 57, 78, 84-86, 88, and 94-96 depend directly or indirectly on one of Claims 2, 5, 14, 16, 18, 19, 25-27, 72, 77, 79, 87, and 89. No new claims have been added. Applicant respectfully requests consideration of the amendments and arguments below.

35 U.S.C. § 112, ¶ 2

Applicant addresses the Examiner's claim rejections under 35 U.S.C. § 112, ¶ 2 as outlined below.

Paragraph (a)

The Examiner rejected Claims 2, 5, and 7 as vague, indefinite, and incomplete based on these claims' recitation of the phrase "easily disrupted." Applicant notes that Claim 7 was previously canceled, and thus rejection of this claim should be withdrawn. Applicant has amended Claims 2 and 5 to clarify that disruption is by physical or chemical stimulation as recited in the amended claims. Support for these amendments can be found, for example, in the Specification at page 11, line 28-page 12, line 3 and page 19, lines 14-20.

Paragraph (b)

The Examiner rejected Claims 14, 16, and 25 as vague and indefinite based on these claims' recitation of a "synthetic polymer." Applicant has amended these claims to remove the term "synthetic" and thereby obviate the rejection. Support for these amendments can be found, for example, in the Specification at page 3, line 12 and page 17, lines 19-24.

Paragraph (c)

The Examiner rejected Claims 18 and 26 as vague, indefinite, and incomplete based on these claims' recitation of the phrase "material that can become soluble." Applicant has amended these claims to clarify that "soluble" is intended to mean "soluble in a solvent . . . selected from the group consisting of water, buffer, acid, alkali, and organic solvent" and has also addressed the Examiner's objection regarding whether this phrase actually limits the claim, thereby obviating the rejection.

Support for the position that the term "soluble" may refer to solubility in water can be found, for example, in the Specification at page 10, line 8. This disclosure clarifies that the term "soluble" is intended to mean "water soluble" absent other considerations as discussed below. Support for the position that the term "soluble" may alternatively refer to solubility in buffer, acid, alkali, or organic solvent can be found, for example, in the Specification at page 11, line 32-page 12, line 3. This disclosure describes embodiments of detection probes utilizing vesicles to carry and release mass tag molecules, where the carriers may be disrupted by chemical stimulation including change of buffer or addition of organic solvent, acid, or alkali to release the mass tag molecule(s). When chemical stimulation comprising addition of a solvent or solution disrupts a carrier, it is implied that the material becomes soluble in the solvent or solution used for stimulation. This is the means by which the mass tag molecule(s) recited in the claim are released. Thus, where physical stimulation or chemical stimulation that does not involve the addition of a solvent or solution is used, the term "soluble" means "water soluble," whereas if chemical stimulation involving the addition of a solvent or solution is used, the term "soluble" means "soluble in water, buffer, acid, alkali, and/or organic solvent." Taken together, this provides written description support for the recitation of "soluble in a solvent . . . selected from the group consisting of water, buffer, acid, alkali, and organic solvent" in amended Claims 18 and 26.

Paragraph (d)

The Examiner rejected Claim 19 as incomplete based on this claim's recitation of a "soluble bead." Applicant has amended this claim to remove the term "soluble," as this limitation is already present in amended Claim 18, upon which Claim 19 depends.

Paragraph (e)

The Examiner rejected Claim 27 as incomplete based on this claim's recitation of "soluble beads." Applicant has amended this claim to remove the term "soluble," as this limitation is already present in amended Claim 26, upon which Claim 27 depends.

Paragraph (f)

The Examiner rejected Claim 72 as vague and indefinite based on this claim's recitation of "synthetic polymers." Applicant has amended this claim, thereby obviating the rejection. Support for this amendment can be found, for example, in the Specification at page 3, line 12 and page 17, lines 19-24.

Paragraph (g)

The Examiner rejected Claims 77 and 87 as vague and indefinite because these claims are process claims that depend on composition claims. However, the Examiner did not provide any support for his assertion that such a combination is an "improper hybrid claim." M.P.E.P. § 608.01(i)(c) provides that "[o]ne or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application. . . . Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim." Thus, a dependent claim directed to a process that refers back to a composition claim will include all of the limitations of that composition claim." Such a claim would be considered a "hybrid" claim because it incorporates both composition and process limitations.

The M.P.E.P. specifically authorizes hybrid claims in at least two sections. M.P.E.P. § 2106(IV)(B) states that "a claimed invention may be a combination of devices that appear to be directed to a machine and one or more steps of the functions performed by the machine. Such instances of mixed attributes, although potentially confusing as to which category of patentable subject matter the claim belongs, does not affect the analysis to be performed by USPTO personnel." Further, M.P.E.P. § 903.08(e) refers to the assignment of applications that include "hybrid" claims to the appropriate Examiner. Thus, nothing in the M.P.E.P. suggests that hybrid claims *per se* would be improper.

35 U.S.C. § 112, ¶ 4, consistent with M.P.E.P. § 608.01(i)(c) referred to above, requires that "a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers." As a result, a dependent claim drawn to a composition that refers to a product, might very well be improper because the composition may not include the limitations of a process.

On the other hand, a process claim that is dependent on a composition claim can quite readily incorporate all the limitations of the composition referred to in the claim it depends from. As noted above, hybrid claims are permissible under the M.P.E.P. The Examiner has pointed to no basis for finding a hybrid claim to be impermissible merely because it is set forth in dependent form. Accordingly, withdrawal of the rejection of Claims 77 and 87 is respectfully requested.

Paragraph (h)

The Examiner rejected Claims 79 and 89 as vague, indefinite, and incomplete based on these claims' recitation of "small chemical molecules." Applicant has amended these claims to remove this phrase, thereby obviating the rejection.

Claims 22, 24, 30, 32, 34, 36, 57, 78, 84-86, 88, and 94-96 depend directly or indirectly on one of Claims 2, 5, 14, 16, 18, 19, 25-27, 72, 77, 79, 87, and 89. As Applicant has addressed the Examiner's rejection of Claims 2, 5, 14, 16, 18, 19, 25-27, 72, 77, 79, 87, and 89 to render these claims in condition for allowance, and the Examiner provided no separate grounds for rejecting Claims 22, 24, 30, 32, 34, 36, 57, 78, 84-86, 88, and 94-96, the latter claims should also now be in condition for allowance.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests withdrawal of the claim rejections and asserts that the present application is in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number appearing below.

Application No.: 10/590,832
Filing Date: August 28, 2006

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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